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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/824,114 | 04/02/2001 | Cheryl Hoffman | 11273/4 | 9174 |
| 26646 | 7590 | 02/27/2004 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004 | | | KANOF, PEDRO R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3628 | |

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Allowability

Application No.

09/824,114

Applicant(s)

HOFFMAN

Examiner

Pedro KANOF

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MM

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.


1. ☒ This communication is responsive to 2/20/04 Supplementary Amendment
2. ☐ The allowed claim(s) is/are 56-89
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 2
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


HYUNG SOO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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DETAILED ACTION

Allowable Subject Matter

1. This communication is in response to the amendment filed 2/20/2004.
2. Claims 56-89 are allowed.
3. The following is an examiner's statement of reasons for allowance:

The claimed invention pertain to a method and system for investing in Brownfields-related projects that are capable of supporting all aspects of a Brownfields remediation, development, redevelopment project, while shielding investors from environmental liability. In this invention an investor's risk of incurring environmental liability is substantially reduced by providing that the Brownfields fund is completely passive with respect to the Brownfields project, taking no security or mortgage interest in the Brownfields.

The searches made by the Examiner on the patents databases of the USPTO, European Patent Office, Japanese Patent Office and World Intellectual Property Organization (WIPO) do not show any patent on private investors investing in Brownfields-related projects. The following list identifies the most relevant prior art pertinent to the claimed inventions:

Wolfberg et al. (US Patent No. 5,214,579) teaches a processing system which manages, monitors and reports the growth of a participant's investment base with respect to progress towards achieving a predetermined target amount selected by the participant. Wolfberg fails to teach using the Brownfields fund which providing investment capital on a non-recourse basis for Brownfields projects and remaining passive with respect to the Brownfields projects.

Luskin et al., (US Patent No. 5,812,987) teaches a method and system for managing assets in one or more investment funds over a specific time, wherein a fund comprises a plurality

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of assets(e.g., stocks, bonds, currencies, gold, silver, oil, gas), and wherein the time horizon represents the expected date at which cash will be withdrawn from the fund is associated with each fund. Luskin does not teach using the Brownfields fund which providing investment capital on a non-recourse basis for Brownfields projects and remaining passive with respect to the Brownfields projects.

Furthermore, Examiner searched Non-Patent Literature, including the following databases: Business Wire, Business Week, PR Newswire, Gale Group (all), McGraw-Hill Publications, World Report 1997-2000, Financial Times, New York Times, Wall Street Journal, Software Reviews Companies and Products, Microcomputer Software Guide, Conference and Papers Index 1973-2000, Dissertation Abstracts Online 1861-2000, INSPEC (IEEE), Inside Conferences, Internet and Personal Computer Abstracts, Wilson Appl. Sci. And Tech. Abstracts, Derwent WIPX, American Banker Publications, Banking Information Source, Bond Buyer Full Text, and Finance & Banking Newsletter, and the most relevant documents regarding this invention are listed on the attached Notice of References Cited ((Form PTO-892).

Thus, the Examiner considers the novelty of the invention to be an investment vehicle which allows private investors to participate in Brownfields-related projects.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion


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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Pedro R. Kanof whose telephone number is (703) 308-9552. The examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hyung Sough, can be reached on (703) 308-0505. The fax phone numbers for this Group are: Customer Service (703) 872-9325, Before Final (703) 872-9326, and After Final (703) 872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

PRK-02/20/04.


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